REMARKS

Claims 1-20 are pending in the application.

By way of this response, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the examiner telephone Eric J. Whitesell at (858)350-9257 so that such issues may be resolved as expeditiously as possible.

Response to the rejection under 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a), allegedly as being unpatentable over Beausang, U.S. Patent No. 5,828,579 (*Beausang*) in view of Nadeau-Dostie et al., U.S. Patent No. 6,457,161 (*Nadeau*). Applicant respectfully traverses the rejection as follows.

Regarding Claims 1, 10, 19, and 20, the rejection alleges on pages 2-4 that it would be obvious to modify *Beausang* with the signal tracing module in *Nadeau* disclosed in column 7, line 67 to column 8, lines 57 to arrive at Claims 1, 10, 19, and 20. The rejection further alleges that one with ordinary skill in the art would have been motivated to make the proposed modification of *Beausang* by *Nadeau* to provide the necessary identification of scan cells for partitioning of scan cells into subgroups that correspond to a common signal domain in *Beausang*.

The rejection argues on page 8 that *Beausang* does not explicitly teach a method or process that can determine which scan chains have the same clock source and alleges that *Nadeau* discloses the step allegedly lacking in *Beausang*. However, the rejection admits on page 4 that this "lacking" step is <u>necessary</u> to *Beausang*. If this step is in fact necessary to *Beausang* and *Beausang* has not sufficiently disclosed how to determine which scan chains have the same clock source as alleged by the rejection, then the rejection is alleging that *Beausang* fails to satisfy the requirement of enablement under 35 USC § 112. However, the USPTO has determined that *Beausang* met the requirement of enablement under 35 USC § 112 when the

patent 5,828,579 was granted. Because the USPTO has determined that *Beausang* met the requirement of enablement under 35 USC § 112, the presumption is established that each and every step necessary to *Beausang* is sufficiently disclosed. Because each and every step necessary to *Beausang* is presumed to be sufficiently disclosed under 35 USC § 112, the allegation that *Beausang* lacks sufficient disclosure for determining which scan chains have the same clock source is refuted by the presumption that each and every step necessary to *Beausang* is sufficiently disclosed. Because the allegation that *Beausang* lacks sufficient disclosure for determining which scan chains have the same clock source is refuted by the presumption that each and every step necessary to *Beausang* is sufficiently disclosed, the argument presented by the rejection to support motivation for making the proposed modification of *Beausang* by *Nadeau* is unsubstantiated. Because the rejection fails to establish a motivation for make the proposed modification of *Beausang* by *Nadeau*, the rejection of Claims 1, 10, 19, and 20 lacks sufficient support to substantiate a rejection under 35 U.S.C. § 103.

Further, *Beausang* (C26 L40 - C27 L13; F2A:315) discloses a computer program that partitions scan segments by clock domain. Because *Beausang* discloses means for determining which scan chains have the same clock source, the argument presented by the rejection to support a motivation to make the proposed modification of *Beausang* by *Nadeau* is unsubstantiated. Because the rejection fails to establish a motivation for make the proposed modification of *Beausang* by *Nadeau*, the rejection of Claims 1, 10, 19, and 20 lacks sufficient support to substantiate a rejection under 35 U.S.C. § 103.

In view of the above, the rejection fails to show that *Beausang* suffers from a lack that would motivate one of ordinary skill in the art to make the modification of *Beausang* by *Nadeau* proposed by the rejection. Because the rejection fails to show that *Beausang* suffers from a lack that would motivate one of ordinary skill in the art to make the modification of *Beausang* by *Nadeau* proposed by the rejection, the rejection fails to establish motivation for making the proposed modification. Because the rejection fails to establish motivation for making the proposed modification, the rejection of Claims 1, 10, 19, and 20 lacks sufficient support to substantiate a rejection under 35 U.S.C. § 103.

The rejection of dependent Claims 2-9 and 11-18 is traversed for the same reasons presented in defense of Claims 1, 10, 19, and 20.

In view of the above, Applicant respectfully requests favorable examination and reconsideration of Claims 1-20.

Respectfully submitted,

/ Eric James Whitesell /

Eric J. Whitesell #38657

Address all correspondence to:

LSI Corporation

1621 Barber Lane, M/S D-106

Milpitas, CA 95035-7458

Direct telephone inquiries to:

Eric J. Whitesell

(858) 350-9257